

Appl. No. 10/780,872
Amdt. dated December 22, 2005
Reply to Office action of September 26, 2005

Claims 1, 2, 5-7, 12 and 14-16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Leriche, U.S. 5,300,076; 4/1994. Claims 1, 2, 8, 12 and 17 stand rejected under 35 U.S.C. § 102(b) as anticipated by Chan, U.S. Pat. 6,607,535; 8/2003. Claims 1, 8, 10 and 11 stand rejected under 35 U.S.C. § 102(e) as anticipated by Zang et al. U.S. Published Application No. U.S. 2005/0177165, 8/2005, filed 2/11/2004.

These rejections are respectfully traversed. At the outset, it is fundamental patent law that: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) Cited in MPEP § 2131.

The claimed invention is a sinus tarsi implant. Several structural limitations are present in the claim that limit the structure to use in the sinus tarsi. For example, the first member, the frustrum, is "operable for insertion into a sinus region of the patient's sinus tarsi." The second member, generally cylindrically shaped, is "operable for insertion into a canalis tarsi region of the patient's sinus tarsi." Yet none of the references, save the Zang published patent application, even mention the sinus tarsi, let alone the sinus region and the canalis region within the sinus tarsi. Zang, does disclose a sinus tarsi implant. Nevertheless, Zang teaches away from the claimed invention because Zang describes a completely conically shaped implant while the claims specifically recite a "generally cylindrically" shaped element. This is found nowhere in Zang.

The Rejection, on page 4, states that "...the intended use language...carries no weight in the absence of any distinguishing structure." It appears that the "intended use" referred to is the

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placement of the implant into the sinus tarsi and specifically into the canalis tarsi region. The associated structure that is described is specifically claimed to perform this function, so there is a distinguishing structure in the claims.

Further, regarding the intended use limitations, precedent at the Federal Circuit states that "every portion of the...claims must be considered..." Application of Duva, 55 C.C.P.A. 829, 835, 387 F.2d 402, 407 (1967). This includes any "intended field of use" limitations and limitations in the preamble. See id.; In re Van Lint, 354 F.2d 674, 680, 53 CCPA 844, 851 (1966). The instant claims have been written to describe an implant that is structurally specific to insertion into the sinus tarsi. This (and all other parts of the claims) should be considered in examination of the claims and, as shown above, none of the prior art references teach or render obvious these limitations.

Claims 9, 11, 18, and 20 are rejected under 35 U.S.C §103. These are dependent claims and the rejections are traversed for at least the reasons detailed above.

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If the Examiner believes a telephone conference would facilitate prosecution, kindly call
Applicant's counsel at the telephone number below.

If additional fees are required, the Commissioner is hereby authorized to charge any
additional fees to deposit account number 11-0853.



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Date: December 22, 2005